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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,401	03/17/2004	Achim Hartlaub	82448	3701
22242	7590	01/19/2006		
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			EXAMINER LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/802,401

Applicant(s)

HARTLAUB ET AL.

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/1/05, 10/31/05, and 11/25/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Vinh T. Luong  
Primary Examiner

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachments 1 and 2</u> .              |

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1. The Amendments filed on August 1, 2005, October 31, 2005 and November 25, 2005 have been entered.

2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 8, 2005.

3. The drawings were received on November 25, 2005. These drawings are accepted by the Examiner.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 17 recites "the skeleton is free of apertures or recesses."

The Examiner respectfully submits that the negative limitation "free of apertures or recesses" does not have basis in the original disclosure, thus, it is new matter. See MPEP 2173.05(i) and the legal precedents cited in the article "*The Introduction of Negative Claim Limitations During Ex Parte Prosecution: 35 USC 112 and the Issue of Antecedent Support*" of Steven J. Hulquist in Journal of the Patent & Trademark Office Society, March 1991, Volume 73, No. 3, page 218.

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In the instant case, Applicant's disclosure does not describe that the skeleton is free of apertures or recesses. To the contrary, the disclosure describes, e.g., in paragraph [0016], that the skeleton does not have to be drilled into. However, the apertures or recesses are not necessarily formed by drilling. In other words, drilling is not the only method to form the apertures or recesses. The apertures or recesses may be formed by, e.g., molding or punching. In other words, Applicant's skeleton may have predetermined apertures or recesses by, e.g., molding or punching. The concept "free of apertures or recesses" is not present in the original disclosure, thus, it is new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973).

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2-6, 9, 11-13 and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schutz (US Patent Publication 2002/0124682 A1).

Regarding claim 16, Schutz teaches a steering wheel for mounting of a build-on part 16, 18, 20, 22, 24, the steering wheel comprising:

- a steering wheel skeleton 10;

- foam material 12 surrounding the skeleton 10; and

- a holding part 32, 42 (Figs. 1-5) that is *substantially* fixed relative to the skeleton 10 by the foam material 12 so that a first portion 42 of the holding part 32, 42 is in the foam material 12 and a second portion 32 of the holding part 32, 42 projects therefrom for mounting of the build-on part 16, 18, 20, 22, 24 thereto.

Regarding claim 2, the holding part 32, 42 *indirectly* bears against the steering wheel skeleton 10 (Fig. 1).

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Regarding claim 3, it is well settled that the patentability of a product does not depend on its method of production. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985); *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); *Ex parte Edwards*, 231 USPQ 981 (BPAI 1986); and MPEP 2113.

Regarding claim 4, an interspace (Attachment 1) filled by the steering wheel foam material 12, is present between the steering wheel skeleton 10 and the holding part 32, 42.

Regarding claim 5, the holding part 32, 42 surrounds the steering wheel skeleton 10 at least partially at one point (Att. 1).

Regarding claim 6, the portion 42 of the holding part 32, 42 has a U-shaped configuration (Figs. 4a-5) adjacent the steering wheel skeleton 10.

Regarding claim 9, the holding part 32, 42 is adjacent a spoke 34 (Fig. 3) of the steering wheel 10.

Regarding claim 11, the holding part 32, 42 is a plastic part. *Ibid.*, paragraph [0018].

Regarding claim 12, the build-on part 16, 18, 20, 22, 24 comprises an adaptor 36 (Fig. 1), which is connected to the holding part 32, 42 and allows an additional build-on part 26 to be connected thereto.

Regarding claim 13, the adaptor 36 is an adaptor plate.

Regarding claim 15, the first portion 42 of the holding part 42, 32 which lies within the steering wheel foam surround 12 has a smaller longitudinal extent than the (second) portion 32 which lies outside the steering wheel foam surround 12.

Regarding claim 17, the skeleton 10 is free of *recesses* for supporting the holding part 32, 42 in substantially fixed relation thereto as seen in Fig. 1.

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Regarding claim 18, the first portion 42 is spaced from the skeleton 10 and embedded in the foam material 12 to be surrounded thereby.

Regarding claim 19, the foam material 12 provides the only holding force between the holding part 32, 42 and the skeleton 10 as seen in Fig. 1.

Regarding claim 20, the skeleton 10 and the holding part 32, 42 inherently have predetermined substantially fixed positions relative to each other via molding of the foam material 12 to surround the skeleton 10 with the skeleton 10 and the holding part 32, 42 in the predetermined substantially fixed positions as shown in Figs. 1-3.

9. Claims 2, 3, 10, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohn et al. (US Patent No. 6,312,012 B1).

Regarding claim 16, Bohn teaches a steering wheel for mounting of a build-on part 30, the steering wheel comprising:

a steering wheel skeleton 1-3;

foam material 4 surrounding the skeleton 1-3; and

a holding part 10, 26 (Figs. 1-3) that is *substantially* fixed relative to the skeleton 1-3 by the foam material 4 so that a first portion 26 (Fig. 2) of the holding part 10, 26 is in the foam material 4 and a second portion (see Attachment 2) of the holding part 10, 26 projects therefrom for mounting of the build-on part 30 thereto.

Regarding claim 2, the holding part 10, 26 bears against the steering wheel skeleton 1-3.

Regarding claim 3, it is well settled that the patentability of a product does not depend on its method of production. *In re Thorpe*, *In re Fessmann*, *Ex parte Edwards*, and MPEP 2113 *supra*.

Regarding claim 10, the holding part 10, 26 is a sheet metal part 8 (Fig. 1).

Regarding claim 14, the holding part 10, 26 is connected to the build-on parts 30 by means of screws or rivets 12 (Fig. 1).

10. Applicant's arguments filed August 1, 2005, October 31, 2005 and November 25, 2005 have been fully considered but they are not persuasive.

At the outset, Applicant contended that claim 16 is not anticipated by Koide. The rejection based on Koide is withdrawn in view of new claim 16. Applicant's arguments regarding Koide are deemed to be moot.

Applicant further argued that Schutz's guide assemblies including the guides 32, springs 41, and bushing 42 are not *substantially* fixed relative to the steering wheel skeleton 10 by the foam casing 12.

The Examiner respectfully submits that the relative term "substantially" is a broad term. *In re Nehrenberg*, 126 USPQ 383 (CCPA 1960) and MPEP 2173.05(b). Therefore, the term "substantially fixed" implies that something less than firmly fixed is required. See "substantially the same as" and "substantially corresponding to" in *Performed Line Products Co. v. Fanner Mfg. Co.*, 124 USPQ 288 (DC N Ohio). In addition, it is well settled that similar structures would behave similarly. *In re Merck & Co., Inc.*, 231 USPQ2d 375 (CAFC 1986).

In the instant case, Schutz's holding part 32, 42 is *substantially* fixed relative to the skeleton 10. In fact, Schutz's holding part 32, 42 is partially mounted or embedded into the foam 12. In the same manner, Applicant's holding part 3 is mounted or embedded into the foam 4 as seen in Fig. 2. Therefore, Schutz's holding part 32, 42 is *substantially* fixed relative to the skeleton 10 in the same manner as Applicant's holding part 3. The necessary inherence of

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Schutz's holding part is flown naturally from Schutz's teaching of the same type of Applicant's fixing. *In re Best*, 195 USPQ 430, 433 (CCPA 1977) and MPEP 2112.

On the other hand, the functional limitations of applicant's claims are not given patentable weight when those limitations are inherent in the Norman reference. See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997)(A reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims). In this case, Schutz's holding part is capable of being substantially fixed relative to the skeleton by the foam material in the same manner as Applicant's holding part, therefore, Applicant's claims are anticipated by Schutz.

For the foregoing reasons, claim 16 and its dependent claims 2-6, 9, 11-13, 15, and 17-20 are unpatentable over Schutz.

11. Applicant's arguments with respect to claims 1-6 and 9-20 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

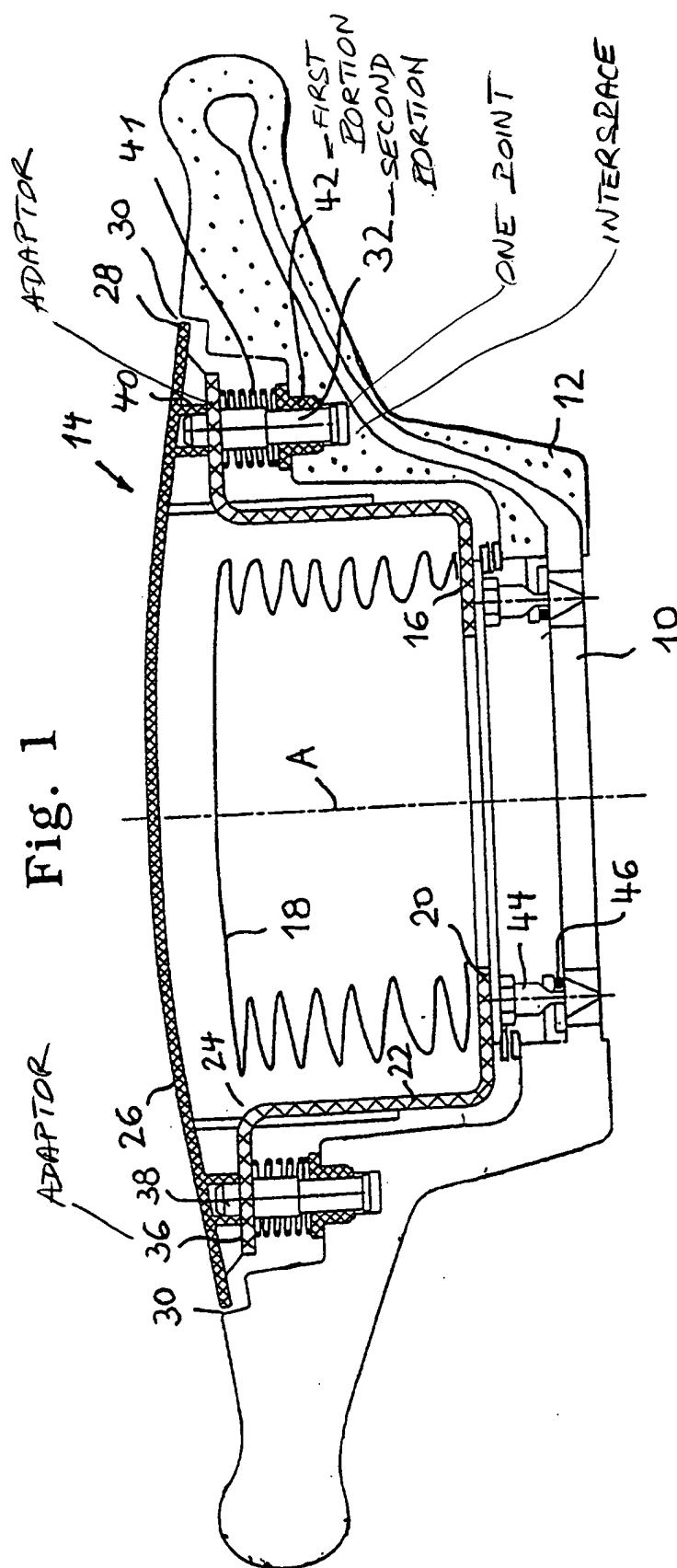
January 17, 2006



Vinh T. Luong  
Primary Examiner

# **ATTACHMENT 1**

# **ATTACHMENT 2**



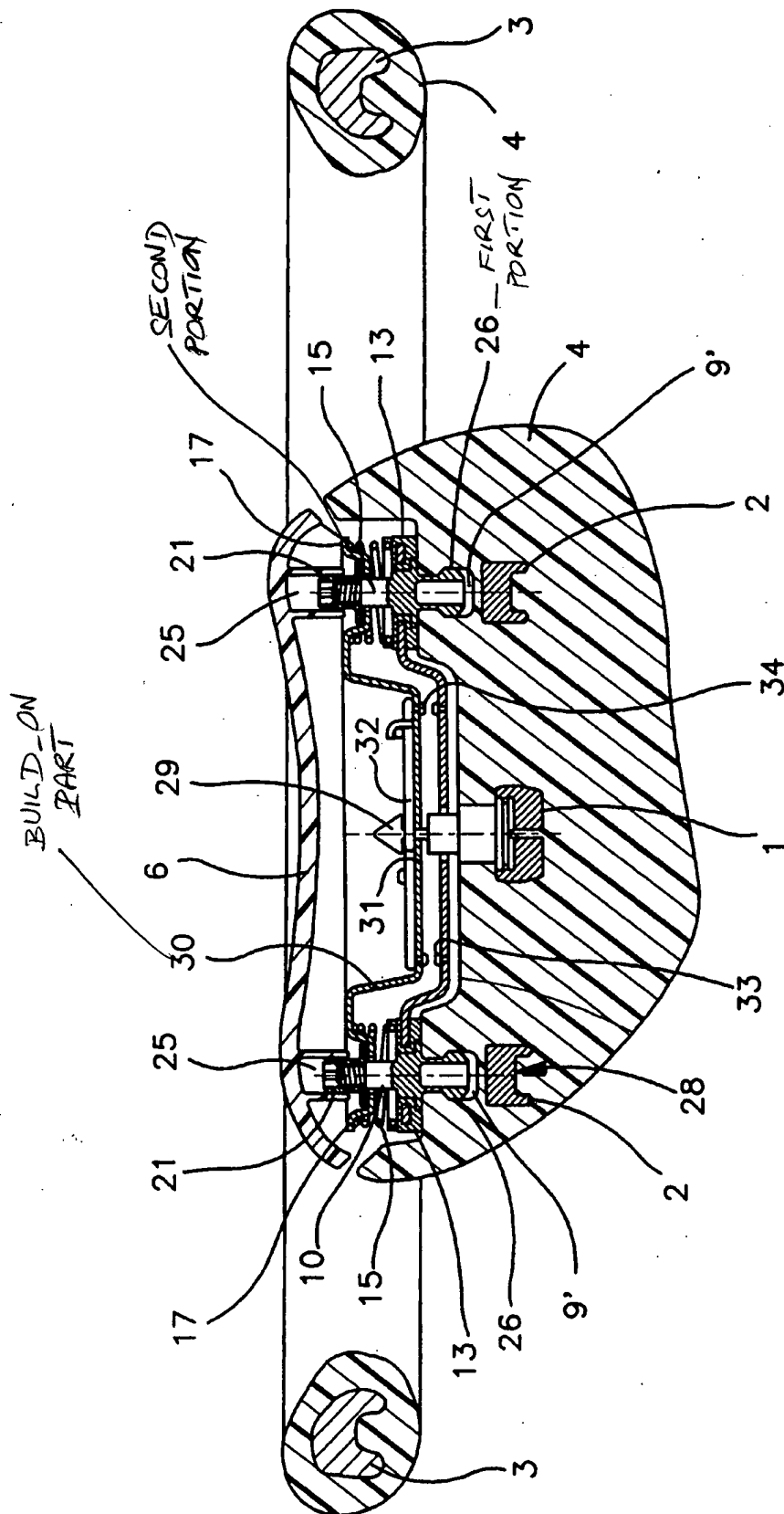


Fig.2